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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/921,199
Filing Date: August 01, 2001
Appellant(s): HOFRICHTER ET AL.

Blakely, Sokoloff, Taylor & Zafman LLP
Eric S. Replogle Reg No. 52, 161
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/13/2010 appealing from the Office action
mailed 04/13/2010

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-2, 4, 8-10 14-20, 24-28, 30-31, 36-39 and 43-50 are pending.

Claims 1-2, 4, 8-10 14-20, 24-28, 30-31,36-39 and 43-50 are rejected.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

I. Claims 9, 19, 30, 38, 48, and 49 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

II. Claims 1, 2, 4, 8-10, 14-20, 24-28, 30, 31, 36-39 and 43-50 stand rejected under 35 U.S.C. § 103(a) as being rendered obvious by Levy et al., U.S. Publication 20030174861, Stefik et al., U.S. Patent No. 5,638,443, and Detlef, et al., U.S. Patent No. 6,848,002.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

20030174861	Levy	9-2003
5638443	Stefik et al	6-1997
6848002	Detlef	1-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

This action is in response to papers filed on December 28, 2009.

Claims 1, 9, 19, 30, 38, 48 and 49 have been amended.

Claims 1-2, 4, 8-10 14-20, 24-28, 30-31, 36-39 and 43-50 are pending.

Claims 1-2, 4, 8-10 14-20, 24-28, 30-31, 36-39 and 43-50 are rejected.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims , 9, 19, 30, 38, 48 and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims contain the limitation “transmitting to the server, a request that the client is to be identified in the list of the plurality of the content providers as an additional content provider that provides the content files” the applicants disclosure lacks support for this amendment, the disclosure as originally presented does not teach/describe a client requesting to be added to the content provider list. The disclosure merely teaches the client becomes content provider of the system when the distribution tool is provided and the system then adds the client to the list of content providers. The content provider does not appear to have the option of being on the list, the only option the provider has is to be removed from the list or be re-instated after expiration. The content provider is automatically added to the list of content providers when requesting the distribution tool.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1-2, 4, 8-10, 14-20, 24-28, 30-31, 36-39 and 43-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 2003/0174861; Levy et al; Connected Audio and Other Media Objects. Hereinafter referred to as Levy, in view of US Patent 5, 638, 443 Stefik et al; System for Controlling the Distribution and Use of Composite Digital Works. Hereinafter referred to as Stefik in further view of US Patent 6,848,002 Detlef System and method for optimal selection and presentation of streaming media types. Hereinafter referred to as Detlef.

4. As to claims 1, 9, 19, 30, 38, 48 and 49 Levy teaches

5. transmitting a request to download data, wherein said data comprises a content file; **(Pg. 5 ¶ 42 “when the user requests a file in a streaming or compressed file format)**

6. receiving identification information and data downloaded from one of a plurality of content providers storing said data, said identification information identifying said one content provider and obtained by said one content provider from an original content provider of said data; transmitting, to said original content provider, said identification information for said one content provider, which downloaded said data, along with payment for the download of said data; **(Pg. 4 ¶ 34 the OID is encoded with additional information about the distributor and identifies the object Pg. 6 ¶ 55 the registration process provides information identifying the attribute of the audio object such as its distributor(content provider) or broadcaster.)**

7. transmitting, to said original content provider, a request for a distribution tool identifying said client as an additional content provider that distributes said data to other

clients; **(PG. 5 ¶ 44 the distributor ID is used for copy control, played, transferred, recorded)**

8. receiving said distribution tool; *wherein the distribution too includes identification information for the server and the client and (Pg 6 ¶ 61 the clearing house embeds the media objects and pushes them to the user) (PG. 2 ¶ 15 identifier may identify media object, entities or actions...)*

9. *Levy teaches the distribution tool is embedded in said data and the distribution tool is subsequently transmitted to the server by the different client after the different client downloads said data from said client(Pg. 3 ¶22-23, Pg. 4 ¶ 30) The examiner notes that these limitations are not positively recited and the steps required(ie different client downloads data) to initiate these steps are not performed therefore the limitations as claimed are outside the scope of the claim and impart no patentable weight and/or eligibility. Applicant never positively claims distributing the data to the different client or the different client downloading data.*

10. Levy fails to teach applying by the client said distribution tool to said data to identify said client as an additional content provider prior to distributing said data to another client, wherein said clients are operated by users of the content file.

11. However, Stefik teaches "distribution and use scenarios" in which he teaches utilizing the consumer as a distributor of the digital works either as a paid or unpaid distributor."(C. 43 I. 28-68). It would have been obvious to one skilled in the art at the time of invention to combine Stefik's consumer distributors with Levy's retail distributors as a simple substitution of the consumer as the distributor rather than a retailer or

broadcaster. This would allow the rights holder to expand their audience while maintaining the usage rights and associated fees while yielding predictable results of expanding the market and audience of the digital works.

12. Levy/Stefik fail to teach the server maintaining a list of plurality of content providers and updating the list to include the client as a content provider for providing the content file transmitting a request that the client be identified and added in the list of the plurality of content providers as an additional content provider of the content file.

However, Detlef teaches a list of content providers that is updated for current providers after accessing registry information(C. 4 l. 61-67). It would have been obvious to one of ordinary skill in the art to include in the content distribution system of Levy/Stefik the ability update the content provider list as providers are registered as taught by Detlef since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable. *The examiner notes that the request to become a content provider of Stefik in combination with the updating of the list implies that the provider is requesting to be added to the list of content providers.*

13. As to claims 2, 4, 10, 14-15, 20 24-25, 31, 36, 39 and 43-44 Levy teaches the distribution tool as being an embedded watermark(Pg 1 12; Pg. 3 ¶ 30).

14. As to claims 8, 16-17, 26-28, 37, 45-47 and 50 Levy teaches transmitting payment to download data and paying distributor royalties(Pg. 4 ¶ 34).e list while also being removed as a provider.

(10) Response to Argument

In response to appellants arguments regarding rejections of claims under 35 USC 112 1st lack of written description requirement.

The rejection sets forth the appellant fails to have an adequate disclosure to support the new limitation of “in response to the client applying the distribution tool, receiving a request that the client is to be identified in the list of the plurality of content providers as an additional content provider that provides the content file”. The limitation is read to mean that the client has already requested and received the distribution tool and then makes a separate request to become a content provider and be added to a list of a plurality of content providers. However, the appellant’s disclosure as originally presented does not support the addition of this limitation of having a separate request to become a content provider in addition to requesting the distribution tool. The appellant argues that support for this limitation can be found in ¶ 25 and 26 of the original disclosure, however, below are the noted paragraphs. (¶27 was not included in arguments but examiner included the paragraph as it is believed the appellant was referring to this section as well)

[0025] In one embodiment, after the distribution tool is received from server 104, client application 112 applies the distribution tool to the encrypted data stored in client database 122 and embeds the identification information into the encrypted data. In one embodiment, the distribution tool is embedded in the encrypted data as a watermark, for example a digital watermark, using one of many known types of watermarking methods. The watermark contains

[0026] In an alternate embodiment, if client 102 decides to become a content provider and subsequently downloads the distribution tool, server 104 may also store the distribution tool and its relationship with client 102 in a list of additional content providers stored within server database 124 and may provide the distribution tool to other clients 102 requesting the same encrypted data, as described in further detail below.

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[0027] In one embodiment, client 102 becomes a content provider for a predetermined period of time. After the predetermined period of time, the distribution tool expires and client application 112 within client 102 needs to send a new request to server 104 to update the distribution tool and to reinstate its status as content provider.

15. The appellant points to the section describing client applying for the distribution tool so as to become a content provider and that the distribution too can expire which requires the client to send a new request to update the distribution tool AND reinstate the clients status as a content provider. (¶ 27) The request is one request to do both steps of updating the distribution tool AND reinstating as content provider, not one request for updating the distribution tool and another request to re-instate content providers status. The examiner notes that the appellant appears to be arguing that the request for reinstatement as disclosed in ¶ 27 is the same as the claimed limitation of "requesting to be identified as a content provider". However, these are two completely different types of requests and different steps in different stages of the process. The client already has to have had the tool distributed and be expired to process a request for updates/reinstatement. The current limitation and claim language states nothing with respect to the clients distribution tool expiring. Why in fact would a distribution tool expire in response to applying the tool to require the reinstatement request as argued by the appellant. As currently written the claim reads that once the client applies the distribution tool they have to make a separate request to initially be included in the list of content providers(not reinstated). However, ¶ 26 of appellants disclosure states the direct opposite of this limitation. The paragraph states "if the client decides to be a content provider and SUBSEQUENTLY downloads the distribution tool....:" this teaches

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that the client has already requested to become a content provider by requesting to have the distribution tool downloaded to their device and downloads(applies) the distribution tool AFTER the client has become a content provider.

Rejections under 35 USC 103

*** The examiner notes that it appears appellant has copied the wrong listing of the claim rejections from a different application in the heading, it appear (via the footer the rejections are taken from 11436008 which is not the case currently before the board on appeal. The examiner has included the proper listing of rejections/claims/references for the boards assistance.*

Claims 1-2, 4, 8-10, 14-20,24-28, 30-31,36-39 and 43-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 2003/0174861 ; Levy et al; Connected Audio and Other Media Objects. Hereinafter referred to as Levy, in view of US Patent 5, 638,443 Stefik et al; System for Controlling the Distribution and Use of Composite Digital Works. Hereinafter referred to as Stefik in further view of US Patent 6,848,002 Detlef System and method for optimal selection and presentation of streaming media types. Hereinafter referred to as Detlef.

In response to appellants arguments regarding rejections under 35 USC 103 the appellant argues that the prior art fails to teach a request that the client is to be identified in a list of the plurality of content providers. The Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in

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view of the state of the art disclosed by the references cited or the objections made.

Further, they do not show how the amendments avoid such references or objections.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981) *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The rejection is a combination of updating the content provider list as cited in Detlef with the request to become a content provider as disclosed in Stefik. The appellant has failed to state how the claimed limitation is different from that of the combination of the prior art cited. The appellant simply states that the prior art fails to teach the limitation. As the examiner believes this limitation is disclosed and show in the cited sections of the prior art of record the appellant fails adequately support the allegation that the teaching is not within the prior art.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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